



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,725	12/15/2000	Bryan R. Goring	NTL-3.2.141/3504(11726STU	1456

35437 7590 03/09/2007
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
666 THIRD AVENUE
NEW YORK, NY 10017

EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
----------	--------------

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/738,725	GORING, BRYAN R.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3622

Response to Amendment

This office action is in response to the Request for Continued Examination, filed January 3, 2007. Claims 1-26 are still pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 19-23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts (US 6,493,110).

Regarding claims 1, 3, 4, 6, 19 and 21 Roberts teaches downloading transaction information (downloaded advertisement with a barcode, that includes transaction data such as redemption amount, expiration or term of offer; identity of coupon holder, issuer, etc (see col. 6 line 64 to col. 7 line 15, col. 18 lines 44-63); downloading the image from a remote location (see fig. 1 personal computer) retrieving an image associated with the transaction information (see fig. 5, col. 7 lines 16-28); converting the image into a pixels matrix representations and printing at least one scan line corresponding to pixel matrix or converting the image into gray scale or dithered black and white pixel matrix (see col. 7 lines 30-40 col. 18 line 63 to col. 19 lines 30, col. 19 line 60 to col. 20 line 31).

Regarding claim 2, Roberts teaches wherein the transaction information includes image information (see abstract and col. 12 lines 41-49).

Regarding claims 5, 7 and 8, wherein the image information is a file name or a URL (see col. 11 lines 49-62).

Regarding claim 9, Roberts teaches wherein the scan line is printed in a predetermined location on a receipt (see col. 19 line 61 to col. 22 line 10).

Regarding claim 20, Roberts teaches the network includes the Internet (see fig. 1).

Regarding claims 22 and 23, Roberts teaches the workstation includes a kiosk or Point-of-sale (POS) terminal (see col. 5 lines 45-67).

Regarding claim 25, Roberts teaches downloading image information from a database; retrieving an image associated with the image information (see fig. 5, col. 7 lines 16-28, col. 6 line 64 to col. 7 line 15, col. 18 lines 44-63); converting the image into grayscale; converting the grayscale image into dithered black-and-white pixels; converting the dithered pixels into pixel matrix representation and printing at least one scan line by selecting printing pixels corresponding to the pixel representation (see col. 7 lines 30-40 col. 18 line 63 to col. 19 lines 30, col. 19 line 60 to col. 20 line 31).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (US 6,493,110) in view of Kanevsky et al. (US 6,334,109).

Regarding claims 10-13, and 15, Roberts teaches downloading transaction information (downloaded advertisement with a barcode, that includes transaction data such as redemption amount, expiration or term of offer; identity of coupon holder, issuer, etc (see col. 6 line 64 to col. 7 line 15, col. 18 lines 44-63); downloading the image from a remote location (see fig. 1 personal computer) retrieving an image associated with the transaction information (see fig. 5, col. 7 lines 16-28); converting the image into a pixels matrix representations and printing at least one scan line; converting the image into pixels matrix representation and printing pixels corresponding to pixel matrix or converting the image into gray scale or dithered black and white pixel matrix (see col. 7 lines 30-40, col. 18 line 63 to col. 19 lines 30, col. 19 line 60 to col. 20 line 31). Roberts does not teach monitoring transaction information, comparing the information to a database. Kanevsky teaches monitoring user transaction and comparing the transaction to an advertisement database and downloading advertisement information from the database responsive to the match and printing the downloaded advertisement on a receipt or coupon (see col. 5 lines 18-57, col. 7 lines 53 to col. 8 line 33). Kanevsky teaches retrieving advertisement associated with the transacting and printing the advertisement (see col. 5 line 18-57). Kanevsky teaches the transaction information including advertisement information (see col. 2 lines 1-40, 60-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Kanevsky's personalized advertisement, by monitoring user's transaction history (past and present) for the intended use of providing advertisement personalized to a particular

Art Unit: 3622

user and to present it at the point of sale by displaying it or printing on the sales terminal as taught by Kanevsky (see abstract).

Regarding claims 14, 16 and 17, wherein the image information is a file name or a URL (see col. 11 lines 49-62).

Regarding claim 18, Roberts teaches wherein the scan line is printed in a predetermined location on a receipt (see col. 19 line 61 to col. 22 line 10).

Regarding claim 26, Roberts does not teach monitoring transaction information, comparing the information to a database. Kanevsky teaches monitoring user transaction and comparing the transaction to an advertisement database and downloading advertisement information from the database responsive to the match and printing the downloaded advertisement on a receipt or coupon (see col. 5 lines 18-57, col. 7 lines 53 to col. 8 line 33). Kanevsky teaches retrieving advertisement associated with the transacting and printing the advertisement (see col. 5 line 18-57). Kanevsky teaches the transaction information including advertisement information (see col. 2 lines 1-40, 60-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Kanevsky's personalized advertisement, by monitoring user's transaction history (past and present) for the intended use of providing advertisement personalized to a particular user and to present it at the point of sale by displaying it or printing on the sales terminal as taught by Kanevsky (see abstract).

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et al. (US 6,334,109) in view of Roberts (US 6,493,110).

Art Unit: 3622

Regarding claim 24, Kanevsky teaches a coupon generator to receive and process purchase information related to a transaction, providing at least one index pointer responsive to the purchase information an advertisement database having accessible coupon fields and the coupon generator incorporating a related coupon advertisement with said purchase information for transmission to an output port (see (see col. 5 lines 18-57, col. 7 lines 53 to col. 8 line 33). Kanevsky does not teach coupon image, it is taught in Roberts. It would have been obvious to one of ordinary skill in the art at the time of the invention to include Roberts' coupon in Kanevsky personalized advertisement for the intended use of providing users with coupon that can be redeemed at a retail/checkout as taught in Roberts.

Response to Arguments

Applicant's arguments filed January 3, 2007 have been fully considered but they are not persuasive.

Applicant argues that Roberts is not a proper 35 U.S.C. 102(e) reference. Examiner respectively disagrees. Roberts meets **(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.** It does not matter when the patent was granted as long as it is published or granted at the time it was applied as a reference and as long as the filing date is before the filing of applicant's invention. Applicant also argues that Roberts does not teach downloading transaction information and retrieving an image associated with the transaction information. Applicant argues that the transaction information is related to consumer transaction rather than related to user demographic and purchasing profiles contrary to examiner's suggestion and recitation of claim 1. Applicant also argues that the disclosure of Roberts is different from the recitation of claim 1, where a

Art Unit: 3622

receipt's image is printed based on transaction information relating to consumer transaction.

Examiner would like to point out that the claim does not recite the argued feature. Therefore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., transaction information related to consumer transaction) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim does not indicate that the downloaded transaction information is related to consumer transaction and that the image retrieved is associated with the consumer transaction. The claim, even though recites a method of printing a receipt in the preamble, there is nothing in the body of the claim that the printing is done on a receipt or coupon. It only recites printing scan line by selectively printing pixels. Therefore, the coupon package, which is downloaded to the user computer, includes transaction information.

Applicant also argues that Roberts does not disclose selectively printing pixels corresponding to the pixel matrix representation. Applicant asserts that Roberts discloses bar code image parameters and how the bar code is defined by its width, stretching factor, misalignment factor printing area, etc. Applicant argues that Roberts does not disclose selectively printing pixels corresponding to the pixel matrix representation. Examiner disagrees. Roberts teaches converting the image (bar code) into (354, 472 or 590 pixel) based on printer resolution and printing the pixels (see col. 19 and 20 and also col. 21 and 22). Referring to Applicant's specification, Applicant admits that the invention makes use of ability of conventional receipt printers to print in a bit image mode. Applicant admits that printers are

Art Unit: 3622

capable of providing a printed scanline composed of individual pixels that can be turned on or off and by printing several scanline in succession or in alternating succession with specified pixels turned on and/or off, the printer may be employed to print high-resolution or low-resolution images (e.g. logos, pictures, a coupon, etc.) see page 4. This feature is also disclosed in Roberts. Applicant argues the combination of Roberts and Kanevsky is improper since Roberts discloses detecting printer resolution and kanevsky discloses system for printing advertisement based on customer information and products purchased by the customer. Examiner would like to point out that Roberts' invention is related to printing coupons using different printer types and the coupons of Roberts is selected based on customer purchasing and demographic information. Kanevsky also teaches printing advertising on unused part of a receipt wherein the advertisement is selected based on current or prior transactions. Kanevsky does not explicitly teach that the advertisement consists of image. Therefore, there is no reason why the combination of the two references is improper. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RETTAYEHDEGA
PRIMARY EXAMINER